



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,820	06/21/2006	Franklin Selgert	03-1111-B	8743
20306 7590 08/03/2009 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER KELLY, RAFFERTY D				
ART UNIT		PAPER NUMBER		
2876				
MAIL DATE		DELIVERY MODE		
08/03/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/583,820

Applicant(s)

SELGERT, FRANKLIN

Examiner

RAFFERTY KELLY

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11,12,14-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11,12,14-20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

Amendment and Request for Continued Examination filed on 5/26/09 have been acknowledged and entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 1, 4, 6-8, 11, 12, 15, 17-19, and 22 are rejected under 35 U.S.C. 102(a) as being anticipated by Schon (Publication No.: US 2005/0071234 A1).

Re claim 1, Schon discloses a system comprising a first device [611], an RF device (cart reader and tag, Fig. 6C), a second device (point of sale), and a server [692] for triggering a first device [611] and logging the triggering, the system comprising a RF chip (cart reader and tag, Fig. 6C) under control of a first party, the first device [611] comprising communication means for receiving an RF signal (cell phone [611] communicates with reader and item identification is transmitted from phone to cart device, p. 8, para. 0083-0088) from the RF chip (cart reader and tag), the first device [611] further comprising communication means for communicating with a network or server of a second party, wherein the first device [611] comprises means to start communicating with the network or server (p. 8, para. 0083-0085, devices are wirelessly connected with each other via RF) after receiving the RF signal, the first device [611] comprises means for sending an enabling ID to the RF chip (cart reader and tag)

(phone transmits shopping list containing item identification to cart reader and tag device), the RF chip comprises means for receiving the ID, and the RF chip (tag of tagged item) comprises memory for storing the ID (Fig. 6A-C, Fig. 7, cart stores list of items and logs and track when those items have been physically put in cart, 8. 8, para. 0088, p. 9, para. 0092), the RF chip comprises means for reading the ID from the memory and transmitting the ID to the second device (point of sale in checkout lane 681); and the second device configured to cause the first party (store) to be financially compensated (para. 0097) for the network communications (network communications is part of the shopping) of the first device triggered by the RF chip based on the received ID.

Re claim 12, Schon discloses a method for triggering a first device [611], logging the triggering, and compensating a party for the triggering, the method comprising the steps of receiving in the first device [611] a RF signal from a RF chip under control of a first party (cart reader and tag, Fig. 6C) of a first party, the first device [611] starting communicating with a network or server of a second party after receiving the RF signal (devices are wirelessly connected with each other via RF, p. 8, para. 0083-0088), sending an ID form the first device [611] to the RF chip (cart reader and tag), receiving the ID in the RF chip (cart reader and tag), and storing the ID in a memory of the RF chip (cart reader and tag) (p. 8, para. 0088, p. 9, para. 0092), reading the ID from the memory of the RF chip and transmitting the ID to a second device (point of sale in checkout lane), and the second device causing the first party (store) to be financially

compensated for the network communications of the first device triggered by the RF chip based on the received ID (para. 0097).

Re claim 4 and 15, Schon discloses the RF chip (cart reader and tag) and the second device are wirelessly connectable, to send the ID (p. 9, para. 0097).

Re claim 6 and 17, Schon discloses billing information is created based on the ID received in the second device (p. 9, para. 0097).

Re claim 7, Schon discloses a system comprising a first device, an RF device, a second device, and a server for triggering a first device [662] and logging the triggering (p. 9, para. 0092), the system comprising a RF chip (tag of tagged item) under control of a first party, the first device [662] comprising communication means for receiving an RF signal ([662] is a reader/writer and tag and therefore contains conventional receiving and transmitting means) from the RF chip (tag of tagged item) (p. 9, para. 0092), the first device [662] further comprising communication means for communicating with a network or server of a second party (computer and portable electronic devices are all in communication with each other, p. 8, para. 0082-0088), wherein the first device [662] comprises means to start communicating with the network or server (network, Fig. 1, p. 3, para. 0038-0039) after receiving the RF signal, the RF chip comprises means for sending an ID to the first device, and the first device comprises for receiving the ID (Fig. 6A-C, Fig. 7, p. 9, para. 0092) and for transmitting the ID to the second device [0097], and the second device configured to cause the first party to be financially compensated for the network communications of the first device triggered by the RF chip based on the received ID (network communications is part of the shopping – para. 0097).

Re claim 18, Schon discloses a method for triggering a first device [662], logging the triggering (p. 9, para. 0092), and compensating a party for the triggering, the method comprising the steps of receiving in the first device [662] a RF signal from a RF chip under control of a first party (tag of tagged item), the first device [662] starting communicating with a network or server (p. 8, para. 0082-0088, p. 3, para. 0038-0039) of a second party after receiving the RF signal, sending an ID from the RF chip (tag of tagged item) to the first device, and receiving the ID in the first device [662] (Fig. 6A-C, Fig. 7, p. 9, para. 0092) and sending the ID to the second device (point of sale - para. 0097), and the second device causing the first party to be financially compensated for the network communications (network communications are part of the shopping) of the first device triggered by the RF chip based on the received ID (para. 0097).

Re claims 8 and 19, Schon discloses the first device [662] comprises a memory for storing the ID ([662] logs item, keeping track of all items in the cart, p. 9, para. 0092) and the first device [662] comprises means for reading the ID from the memory and sending the ID to a second device ([662] then transmits the log of items to the register, p. 9, para. 0097).

Re claims 11 and 22, Schon discloses billing information is created based on the ID received in the second device (total is based on items with the tag ID so proper charge is made, p. 9, para. 0097, Fig. 7).

Re claim 13, Schon discloses the step of reading the ID from the memory and sending the ID from the RF chip (tagged item) to a second device.

Re claim 15, Schon discloses sending the ID from the RF chip (tagged item) to the second device via a wireless connection.

Re claim 17, Schon discloses the step of creating billing information based on the ID received.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5, 9, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schon as applied to claims 1, 8, 12, and 19 above, and further in view of Attia (Publication No.: US 2002/0016750 A1). The teachings of Schon are stated above.

Re claims 5, 9, 16, and 20, Schon fails to teach a means to clear the memory after sending the ID.

Attia teaches a means to clear the memory after sending the ID (p. 2-3, para. 0019-0020).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Schon with Attia so that pervious item IDs from previous purchases aren't accidentally repurchased when the system is used again, and in a public setting to provide privacy so that the next user of the device does not have access to the pervious user's information.

3. Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schon as applied to claims 1 and 12 above, and further in view of Blossom (Publication No.: US 2003/0019942 A1). The teachings of Schon are stated above.

Schon fail to disclose the RF chip and the second device are physically connectable. Blossom teaches an RF chip and device are physically connectable (Fig. 1, p. 1, para. 0003, p. 2, para. 0018, 0025).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Schon with Blossom because making an RF chip contact or contactless connectable to a device was known in the art and would yield predictable results.

Response to Arguments

Applicant's arguments filed 5/26/09 have been fully considered but they are not persuasive. Applicant argues that Schon does not teach the newly amended features regarding the second device and the financial compensation to the first party. However, this argument is not found to be persuasive. See the above detailed rejection for citations of where Schon teaches the claimed features. Schon teaches transmitting the ID to a second device (transmits product IDs to the point of sale at the checkout lane). The first party (store) is then financially compensated for the purchasing of the items, which includes the network communications.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAFFERTY KELLY whose telephone number is (571)270-5031. The examiner can normally be reached on Mon. - Fri. 800-1730 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rafferty Kelly/
Examiner, Art Unit 2876
7-30-09

/Michael G Lee/
Supervisory Patent Examiner, Art Unit 2876